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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,557	10/24/2003	Erik Yi Zhang	100204185-1	3595

22879 7590 02/23/2005

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FORT COLLINS, CO 80527-2400

EXAMINER

BOLLINGER, DAVID H

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,557

Applicant(s)

ZHANG ET AL.

Examiner

David H Bollinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-26, 36, 37, 46, 47 and 49-52 is/are allowed.
- 6) ☒ Claim(s) 1-3, 13-17, 21, 22, 27-33, 38, 39, 42-45 and 48 is/are rejected.
- 7) ☒ Claim(s) 4-12, 18-20, 34, 35, 40 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 27 through 31, 39, 42 through 45 and 48 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 27 through 31, 39, 42 through 45 and 48 are ambiguous since these claims recite limitations to both steps in a method and structure of an apparatus. Accordingly, it is unclear whether the claims are directed to a method or an apparatus. Examples of the recitation of apparatus limitations are claim 27 lines 8-9, claim 29 lines 2-4, claim 31 lines 3-4, claim 39 lines 2-4, claim 42 lines 7-9, claim 45 lines 3-4 and claim 48 lines 2-4.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 27 through 31, 39, 42 through 45 and 48 are rejected under 35

U.S.C. 101 because these claims recite limitations to both a method and an apparatus for performing the method, therefore; the claims are directed to neither a "process" nor a "machine", but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 through 3, 13 through 15, 17, 21, 22, 27, 32, 33, 38, 39 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Yergenson.

Not the portion of the biasing structure comprising spring 22 is received within an opening (un-numbered) in the bottom of tray 10.

Yergenson also teaches an adjustment control operably secured to the biasing structure to adjust a biasing force applied to the media sheets (see the abstract lines 19-32, column 1 lines 39-42 and column 2 line 61 through column 3 line 17).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yergenson in view of Peter.

Yergenson as interpreted above in paragraph 6 teaches everything except an ink jet printer being the image forming apparatus.

Peter teaches a sheet media feeder employed with an ink jet printer (see the abstract).

It would have been obvious to one of ordinary skill in the art to have the image forming apparatus associated with the sheet media feeder of Yergenson be an ink jet printer in view of the teachings of Peter.

10. Claims 4 through 12, 18 through 20, 34, 35, 40 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 23 through 26, 36, 37, 46, 47 and 49 through 52 are allowed.

12. Applicant's arguments filed 30 November 2004 have been fully considered but they are not persuasive. Applicant's remarks regarding a rejection of claims 4-12, 18-20, 23-26, 28-30, 34 and 35 under 35 USC 112 second paragraph not being found are well taken. The paragraph in the previous Office action objecting to the above claims incorrectly referenced a rejection of the claims under 35 USC 112 second paragraph

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and should have merely stated the requirement to write the claims in independent form incorporating the limitations of the independent claim and any intervening claims.

Further, applicant has argued that the prior art does not teach and disclose the claimed combination as recited in amended claims 1, 13, 21, 27 and 32. Specifically, these claims do not recited the limitation of the portion of a similar recitation in original claim 4.

As stated above Yergenson teaches positioning a part of the biasing structure comprising the spring 22 in a opening.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H Bollinger whose telephone number is 703-308-1113. The examiner can normally be reached on Monday through Friday from 9:00 am to 5:00 pm.

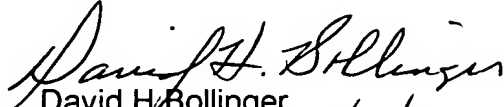
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David H. Bollinger
Primary Examiner 2/21/05-
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